LIBRARY
SUPREME COURT, U. S.

FILED
SEP 25 1968
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 565

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

ROBERT H. RINES
DAVID RINES
Rines and Rines
Ten Post Office Square
Boston, Massachusetts 02109

NELSON H. SHAPIRO
Washington Building
Washington, D. C.

Attorneys for Petitioner

September, 1968

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

INDEX

	Page
Opinion below	1
Jurisdiction	2
Question presented	2
Constitutional and statutory provisions involved	2
Statement	3
Reasons for granting the writ	5
Conclusion	8
Appendix	1a

CITATIONS

CASES:

Addressograph-Multigraph Corp. v. *Cooper*, 156 F. 2d 483	6
Brenner v. *Manson*, 383 U.S. 519	5
Bresnick v. *United States Vitamin Corp.*, 139 F. 2d 239	6
Carbice Corp. v. *American Patents Development Corp., et al.*, 283 U.S. 27	7
Kleinman v. *Steinbach*, 187 F. 2d 743	5
Sinclair Co. v. *Interchemical Corp.*, 325 U.S. 327	5
Standard Sanitary Mfg. Co. v. *United States*, 226 U.S. 20	7
United States v. *Du Pont & Co.*, 366 U.S. 316	7

CONSTITUTION AND STATUTES:

U.S. Constitution: Article I, Section 8, Clause 8	2
28 U.S.C. 1256	2, 5
35 U.S.C. 101	2
35 U.S.C. 112	3, 4

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No.

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

The petitioner, Edward Fredkin, prays that a writ of certiorari issue to review the final judgment of the United States Court of Customs and Patent Appeals entered in this case on June 27, 1968.

OPINION

The opinion of The Court of Customs and Patent Appeals appears as Item 3 of the Transcript herein and is reported at 158 U.S.P.Q. 280; and only the pertinent portions thereof for purposes of this petition and the sole issue raised thereby are reproduced herein (App. *infra*, p. 1a).

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 27, 1968. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTION PRESENTED

Now that it is an Article III Court, is the Court of Customs and Patent Appeals *powerless,* as it has specifically held in this case, to protect the public by preventing the issuance of an admittedly invalid patent claim to one party because the other party to a patent interference failed in the early stages of the interference to present reasons for such invalidity; or, do the public interest, jurisdiction and duty of an Article III Court require the intervention of that Court whenever the invalidity of a claim is patently demonstrated?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8, clause 8, of the Constitution of the United States provides:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

28 U.S.C. 1256 provides:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 101 provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 112 provides:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

STATEMENT OF THE CASE

This cause involves an attempt by The National Cash Register Company, assignee of the patent application of the respondent Irasek (Trans. of Record, p. 4) to take away from your petitioner Fredkin, assignor to a small science-based company, Bolt Beranek & Newman, Inc., by way of patent interference proceedings in the Patent Office, a patent (Transcript of Record p. 177) that had been issued by the Patent Office to your petitioner.

Although the challenged patent and the interference application cover complicated auxiliary equipment for use with computers and the like, the *technology is irrelevant for purposes of this petition and no technical understanding or issue* is involved herein.

The question is merely whether The National Cash Register Company may be awarded a patent claim

(claim 4)[1] to which the findings of the Court show it is not entitled because the subject matter is not disclosed in the Irasek application,[2] merely because of the technicality that Fredkin, through what the Court found to be 'a misunderstanding', did not, in the early stages of the interference, call the attention of the Patent Office to this lack of disclosure in the Irasek application.

In other words, though the Court of Customs and Patent Appeals *now* knows that, claim 4 unequivocally specifies a "magnetic coupling", and that The National Cash Register Company even admits that the Irasek application contains no disclosure of a "magnetic coupling", the Court has held that it is powerless, as it construes its jurisdiction and duty, to prevent the awarding of that claim to The National Cash Register Company merely because Fredkin, through 'misunderstanding', did not call attention to this fact early in the interference proceedings in the Patent Office.

The Court's specific findings were (App., *infra*):

a) Claim 4 specifies "said coupling means *being magnetic*".

b) All that the Irasek application admittedly discloses is "an electromagnet to turn card-holding rods", not even a "coupling".

---

[1] Claim 4 (count 4 of the interference), reads: "4. The apparatus of claim 1, *said coupling means being magnetic.*" (Transcript of Record, p. 185).

A similar holding was also made with regard to count 3.

[2] 35 U.S.C. 112, *supra*, requires disclosure in "full, clear, concise, and exact terms" to obtain a patent claim.

c) "Irasek answered negatively as to whether he disclosed 'magnetic, as distinguished from electromagnetic, coupling means . . ."

And then, the most startling assertion:

d) "that Irasek will obtain a patent with an *invalid claim . . . is not a matter which can be considered here. Kleinman* v. *Steinbach,* 38 CCPA 924, 187 F. 2d 743, 89 USPQ 151 (1951)."

Your petitioner fails to find authority in the *Kleinman* case or any other case, that invalidity of a patent claim "is not a matter which can be considered" by an Article III appellate court!

REASONS FOR GRANTING THE WRIT

This Supreme Court has made plain in *Brenner* v. *Manson,* 383 U.S. 519, 148 U.S.P.Q. 689 (1966), that a decision of the Court of Customs and Patent Appeals

"is that of an Article III court. It is 'judicial' in character";

and that 28 U.S.C. 1256

"authorizes the grant of certiorari".

1. It is, accordingly, believed to be imperative for this Supreme Court to determine promptly whether such an Article III court possesses *less* jurisdiction and duty than all other Article III courts, which this Supreme Court has consistently charged with the task of continually determining validity of claims as a matter of great "public importance", *Sinclair Co.* v. *Interchemical Corp.,* 325 U.S. 327, 330 (1944).

This mandate from the Supreme Court continually to determine and act on invalidity has been followed by all other Article III courts throughout the land, except for the Court of Customs and Patent Appeals which, as above quoted, seems to feel it has no power, as in the present case, to prevent issuance of an invalid patent claim unless this matter had been raised from the very beginning in the Patent Office.

Thus, for example, in the 2nd Circuit, the courts follow this mandate, *Addressograph-Multigraph Corp.* v. *Cooper,* 156 F. 2d 483, 485 (2 Cir., 1946):

> "The reason for this is the importance to the public generally that an invalid patent 'should not remain in the art as a scarecrow.' *Bresnick* v. *United States Vitamin Corp.,* 2 Cir., 139 F. 2d, 239, 242."

Only the Court of Customs and Patent Appeals, among all the Article III appellate courts of the land thus feels that invalidity is a question that cannot even "be considered" by the court on its own.

And when it is remembered that the Court of Customs and Patent Appeals is in the unique position of being the *only* appellate court from the Patent Office, and the very court, accordingly, that authorizes the grant of thousands of patents, the importance of the prompt resolution of its powers and duties in this particular, is made all the more evident.

In the above-mentioned *Brenner* v. *Manson* case, moreover, this Supreme Court almost informed the Court of Customs and Patent Appeals of its duty in the premises; but not quite. Specifically, in footnote (12), this Supreme Court reiterated the duty of the

patent examiner to determine patentability before declaring an interference, stating

> "the examiner, 'before the declaration of an interference' must determine the patentability of the claim *as to each party.*" (emphasis supplied).

But the Supreme Court did not go on to say that, during the interference, the Court of Customs and Patent Appeals is charged with a similar duty, particularly if, on the face of the record, it appears that a claim would be invalid if issued in one party's patent.

It is urged that the time has come so to instruct the Court of Customs and Patent Appeals lest the highly undesirable result continue that patents be spawned with clearly invalid claims—the "scarecrow" patents referred to in the *Addressograph* case, *supra.*

2. This Court will take judicial notice of the dominant position of The National Cash Register Company in the field in question, and should properly share the concern of your petitioner (and presumably the rest of the computer industry) as to the improper monopolistic effect of placing in the hands of such a dominant corporation an invalid instrument for restraining commerce—a practice long condemned by this Supreme Court as violative of our anti-trust laws, *Standard Sanitary Mfg. Co.* v. *United States,* 226 U.S. 20; *Carbice Corp.* v. *American Patents Development Corp., et al.,* 283 U.S. 27, 34 (1931); and, at the very least, an improper instrument that would certainly, by its effect, have the "tendency towards monopoly" condemned by the Supreme Court in *United States* v. *DuPont & Co.,* 366 U.S. 316, 325-6.

And the irony is that this improper patent which would be used in violation of the anti-trust laws is an

instrument that the Court of Customs and Patent Appeals would have itself decreed should be issued!

It certainly appears to be an urgent matter to clarify whether such court-sanctioned invalid patents must continue to be spawned under what your petitioner believes to be a clearly erroneous interpretation by the Court of Customs and Patent Appeals as to its powers and duties, particularly now that it is an Article III court.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

ROBERT H. RINES
DAVID RINES
Rines and Rines
Ten Post Office Square
Boston, Massachusetts 02109

NELSON H. SHAPIRO
Washington Building
Washington, D. C.

Attorneys for Petitioner

September, 1968